

## **REMARKS**

Claims 21-40 were examined and reported in the Office Action. Claim 21 is amended. Claims 21-40 remain. Applicant requests reconsideration of the application in view of the following remarks.

### **I. In the Drawings**

The Office Action states the drawings are objected to because of incorrect cross-hatching of the plastic mounting ring components. Applicant has amended the figures and submits three replacement sheets including Figures 1-2, 3-4 and 6-7, respectively. Approval is respectfully requested.

### **II. 35 U.S.C. § 112**

It is asserted in the Office Action that claims 21-40 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 21 to overcome the 35 U.S.C. § 112, second paragraph rejection.

Accordingly, withdrawal of the 35 U.S.C. § 112 rejection for claims 21-40 are respectfully requested.

### **III. 35 U.S.C. § 102(e)**

It is asserted in the Office Action that claims 21-23, 26, 31, 32, 34, and 35 are rejected under 35 U.S.C. § 102(e), as being anticipated by U. S. Patent No. 6,394,507 issued to Baker (“Baker”). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2131,

’[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’ (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.

1987)). ‘The identical invention must be shown in as complete detail as is contained in the ... claim.’ (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Applicant’s claim 21 contains the limitations of

[a] pipe coupling for connecting a pipe to a counter-flange associated with another pipe in a sealed manner, wherein the pipe is formed with a circumferential groove, the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

Baker discloses a device for connecting tubular bodies with flange assemblies. In Baker, two semiannular tongues 118 at each side are used to form together hub segment 120 (see Baker, col. 9, lines 21-38). Distinguishably, Applicant’s elastically expandable mounting ring 18 is formed with an upright shoulder 18d. Therefore, Applicant’s claimed invention only includes a single gasket that seals the coupling, which is different from the three gaskets required by Baker.

Baker does not teach, disclose or suggest Applicant’s claim 21 limitations of

the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

Therefore, since Baker does not disclose, teach or suggest all of Applicant’s claim 21 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(e) can not be adequately set forth relative to Baker. Thus, Applicant’s claim 21 is not anticipated by Baker. Additionally, the claims that directly or indirectly depend on claim 21, namely claims 22-23, 26, 31, 32, 34 and 35 are also not anticipated by Baker for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 102(e) rejections for claims 21-23, 26, 31, 32, 34 and 35 are respectfully requested.

#### IV. 35 U.S.C. § 103(a)

A. It is asserted in the Office Action that claim 24 is rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Baker in further view of U. S. Patent 1,942,489 issued to Pfefferle ("Pfefferle").

Applicant's claim 24 indirectly depends on amended claim 21. Applicant has addressed Baker regarding claim 21 in section III. As asserted above, Baker does not teach, disclose or suggest Applicant's claim 21 limitations of

the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

According to MPEP §2142

[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974))." "*All words in a claim must be considered in judging the patentability of that claim against the prior art.*" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Pfefferle discloses a packing gasket for pipe joints. Pfefferle, however, does not teach, disclose or suggest Applicant's amended claim 21 limitations of

the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

Since neither Baker, Pfefferle, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claim 21, as listed above, Applicant's amended claim 21 is not obvious over Baker in view of Pfefferle since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claim that indirectly depends from amended claim 21, namely claim 24, would also not be obvious over Baker in view of Pfefferle for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for claim 24 is respectfully requested.

**B.** It is asserted in the Office Action that claim 25 is rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Baker, and further in view of U. S. Patent 5,779,285 issued to Robinson ("Robinson").

Applicant's claim 25 directly depends on claim 21. Applicant has addressed Baker regarding claim 21 in section III.

Robinson discloses a coupling assembly for joining large diameter pipes, where the major components, except the gaskets, are made of high strength plastic material. Even if Baker is integrated with Robinson, however, the resulting invention would still not teach, disclose or suggest Applicant's claim 21 limitations of

the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting

there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

Since neither Baker, Robinson, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's claim 21, as listed above, Applicant's claim 21 is not obvious over Baker in view of Robinson since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claim that directly depends from claim 21, namely claim 25, would also not be obvious over Baker in view of Robinson for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for claim 25 is respectfully requested.

C. It is asserted in the Office Action that claim 27 is rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Baker, and further in view of U. S. Patent 3,381,983 issued to Hanes ("Hanes").

Applicant's claim 27 indirectly depends on amended claim 21. Applicant has addressed Baker regarding claim 21 in section III.

Hanes discloses a tool joint includes a pin member that is receivable in a box member with a split lock ring that couples the members together. Even if Baker is integrated with Hanes, however, the resulting invention would still not teach, disclose or suggest Applicant's claim 21 limitations of

the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

Since neither Baker, Hanes, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's claim 21, as listed above, Applicant's claim 21 is not obvious over Baker in view of Hanes since a *prima facie* case of obviousness has not been met

under MPEP §2142. Additionally, the claim that indirectly depends from claim 21, namely claim 27, would also not be obvious over Baker in view of Hanes for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for claim 27 is respectfully requested.

**D.** It is asserted in the Office Action that claims 28 and 33 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Baker, and further in view of U. S. Patent 3,284,112 issued to Martin ("Martin").

Applicant's claims 28 and 33 either directly or indirectly depend on amended claim 21. Applicant has addressed Baker regarding claim 21 in section III.

Martin discloses a pipe coupling including a shoulder 14 that prevents insert 2 from being pulled through bores 10. Even if Baker is integrated with Martin the resulting invention would still not teach, disclose or suggest Applicant's claim 21 limitations of

the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

Since neither Baker, Martin, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's claim 21, as listed above, Applicant's claim 21 is not obvious over Baker in view of Martin since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from claim 21, namely claims 28 and 33, would also not be obvious over Baker in view of Martin for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for claims 28 and 33 is respectfully requested.

**E.** It is asserted in the Office Action that claim 29 is rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Baker in view of Martin and further in view of U. S. Patent 1,976,589 issued to Trickey ("Trickey").

Applicant's claim 29 indirectly depends on amended claim 21. Applicant has addressed Baker in view of Martin regarding claim 21 in section IV(D).

Trickey discloses a pipe joint that uses rubber as a gasket. Even if Baker is integrated with Martin and Trickey the resulting invention would still not teach, disclose or suggest Applicant's claim 21 limitations of

the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

Since neither Baker, Martin, Trickey, and therefore, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's claim 21, as listed above, Applicant's claim 21 is not obvious over Baker in view of Martin and Trickey since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claim that indirectly depends from claim 21, namely claim 29, would also not be obvious over Baker in view of Martin and Trickey for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for claim 29 is respectfully requested.

**F.** It is asserted in the Office Action that claim 30 is rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Baker in view of Martin in view of Trickey and further in view of U. S. Patent 6,367,803 issued to Loth ("Loth").

Applicant's claim 30 indirectly depends on claim 21. Applicant has addressed Baker in view of Martin and Trickey regarding claim 21 in section IV(E).

Loth discloses a sealing ring including a rigid metal annular part with radiating metal lugs that can be folded along the contour of the support flange. Even if Baker is integrated with Martin, Trickey and Loth, the resulting invention would still not teach, disclose or suggest Applicant's claim 21 limitations of

the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

Since neither Baker, Martin, Trickey, Loth, and therefore, nor the combination of the four, teach, disclose or suggest all the limitations of Applicant's claim 21, as listed above, Applicant's claim 21 is not obvious over Baker in view of Martin, Trickey and Loth since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claim that indirectly depends from claim 21, namely claim 30, would also not be obvious over Baker in view of Martin, Trickey and Loth for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for claim 30 is respectfully requested.

**G.** It is asserted in the Office Action that claim 36 is rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Baker, and further in view of U. S. Des. 284,022 issued to Milot et al ("Milot").

Applicant's claim 36 indirectly depends on claim 21. Applicant has addressed Baker regarding claim 21 in section III.

Milot discloses a design for a backing ring for a pipe coupling. Even if Baker is integrated with Milot the resulting invention would still not teach, disclose or suggest Applicant's claim 21 limitations of

the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting



there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

Since neither Baker, Milot, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's claim 21, as listed above, Applicant's claim 21 is not obvious over Baker in view of Milot since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claim that indirectly depends from claim 21, namely claim 36, would also not be obvious over Baker in view of Milot for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for claim 36 is respectfully requested.

**H.** It is asserted in the Office Action that claim 37 is rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Baker, and further in view of U. S. Patent 2,779,610 issued to Risley ("Risley").

Applicant's claim 37 is directly dependent on claim 21. Applicant has addressed Baker regarding claim 21 in section III.

Risley discloses pipe couplings for connecting pipes in a flexible fluid-tight relationship. Even if Baker is integrated with Risley the resulting invention would still not teach, disclose or suggest Applicant's claim 21 limitations of

the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

Since neither Baker, Risley, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's claim 21, as listed above, Applicant's claim 21 is not obvious over Baker in view of Risley since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claim that directly depends from claim 21, namely claim 37, would also not be obvious over Baker in view of Risley for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for claim 37 is respectfully requested.

**I.** It is asserted in the Office Action that claims 38-39 is rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Baker, in view of Risley, and further in view of Seiler.

Applicant's claims 38-39 are indirectly dependent on claim 21. Applicant has addressed Baker in view of Risley regarding claim 21 in section IV(H).

Seiler discloses metal inserts interposed between adjacent segments. Even if Baker is integrated with Risley and Seiler the resulting invention would still not teach, disclose or suggest Applicant's claim 21 limitations of

the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

Since neither Baker, Risley, Seiler, and therefore, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's claim 21, as listed above, Applicant's claim 21 is not obvious over Baker in view of Risley and Seiler since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that indirectly depends from claim 21, namely claims 38-39, would also not be obvious over Baker in view of Risley and Seiler for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 38-39 are respectfully requested.

**J.** It is asserted in the Office Action that claim 40 is rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Baker.

Applicant has addressed Baker regarding claim 21 in section III. As asserted above, Baker does not teach, disclose or suggest Applicant's claim 21 limitations of

the coupling comprising a single gasket, a mounting ring, and a mounting flange having a coned shaped inner surface, wherein said mounting ring has a cone-shaped outer surface and is elastically expandable and engages the groove by projection portions fitting there into and holding the ring affixed to the pipe when tightened towards the counter-flange.

Since Baker does not teach, disclose or suggest all the limitations of Applicant's amended claim 21, as listed above, Applicant's amended claim 21 is not obvious over Baker in view of no other prior art since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claim that directly depends from amended claim 21, namely claim 40, would also not be obvious over Baker in view of no other prior art for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for claim 40 is respectfully requested.

**V. Allowed Subject Matter**

Applicant notes with appreciation the Examiner's assertion that claims 38 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant respectfully asserts that claims 21-40 as they now stand, are allowable for the reasons given above.

### **CONCLUSION**

In view of the foregoing, it is submitted that claims 21-40 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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Dated: April 18, 2007

By: \_\_\_\_\_

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### **CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.

\_\_\_\_\_  
Jean Svoboda

\_\_\_\_\_  
April 18, 2007

Date